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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/640,367	08/13/2003	John A. Reeve	MSH - 245	8435
8131	7590	05/16/2005	EXAMINER	
MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND, MI 48640			TUROCY, DAVID P	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 05/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/640,367

Applicant(s)

REEVE, JOHN A.

Examiner

David Turocy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 9-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-34, 36-38, 40, 41, 43-45, 47, 48, 50-52 and 54 is/are rejected.
- 7) ☒ Claim(s) 35, 39, 42, 46, 49 and 53 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The applicant's amendments, filed 4/8/2005, have been fully considered and reviewed by the examiner. In light of the amendment to claims 2 and 3, the objection to the claims for minor informalities has been withdrawn. In light of the cancellation of the claims 7 and 8, the objection to the claims for not further limiting has been withdrawn. The examiner notes the amendments to claims 10, 12, 14, 16, 22, 28, 34-37, 39, 41-44, 46, 48-51, and 53, therefore the 35 USC 112 first paragraph rejection for enablement has been withdrawn. Claims 1-6 and 9-54 pending.

### ***Response to Arguments***

2. Applicant's arguments filed 4/8/2005 have been fully considered but they are not persuasive.

The applicant has argued against the Gosset et al. reference stating that since the potassium silicate is within the coating material one of ordinary skill in the art would not be motivated to separate the potassium silicate from the entire coating composition. The examiner respectfully disagrees.

Lohmer teaches of a method of treating a solid substrate comprising reacting the substrate with a silane and then coating the surface with a *hydrophobic compound*. Lohmer discloses successful hydrophobic compounds include ones containing functional groups and lists various exemplary compounds (Paragraph 0052-0054). However, It is the examiners position that such a listing of hydrophobic compounds is

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not exhaustive and therefore various other hydrophobic compounds can reasonably be expected to effectively provide a solid substrate with water repellency.

The examiner agrees Gosset et al utilizes potassium silicate within a coating material, however, Gosset et al discloses various compounds, including potassium silicate, each of which includes a functional group, to imparting water repellency. One of ordinary skill in the art would reasonably expect the compounds, as taught by Gosset et al, to impart hydrophobic properties in the coating process as taught by Lohmer.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-3, 10-34, 36-38, 40-41, 43-45, 47-48, 50-52, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Publication 2002/0048679 by Lohmer et al ("Lohmer") in view of US Patent 4632848 by Gosset et al ("Gosset").

5. The claims are rejected for the same reasons as discussed in the Office action date January 7, 2005 and for the reasons set forth in section 2 above.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 4-6, 9, 20, 26, and 32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 20 of copending Application No. 10/052002. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application teaches of providing a substrate contacting with an aqueous solution including a dianion and catalyst and then subsequently contacting with a silicon-containing material all of which are required by the present claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Allowable Subject Matter***

8. Claims 35,39,42,46,49, and 53 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: none of the prior art cited or reviewed by the examiner discloses or reasonably suggests applying a *polymeric siloxane or silicon/organic copolymer* to a solid substrate followed immediately with another silicon-containing material as disclosed by the independent claims.

***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy  
AU 1762



**TIMOTHY MEEKS**  
**SUPERVISORY PATENT EXAMINER**